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Filing date: **07/18/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91208141
Party	Plaintiff Goya Foods, Inc.
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Submission	Motion to Strike
Filer's Name	John M. Rannells
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Signature	/John Rannells/
Date	07/18/2013
Attachments	Motion to Strike 7-18-13.pdf(124552 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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GOYA FOODS, INC.	:	Opposition No.: 91208141
	:	
Opposer,	:	
	:	
v.	:	
	:	Mark: CASERA
MARQUEZ BROTHERS INTERNATIONAL,	:	Ser. No. 85430918
INC.	:	
	:	
Applicant.	:	
	:	
-----X		

**MOTION TO STRIKE APPLICANT FIRST AND SECOND AFFIRMATIVE
DEFENSES SET FORTH IN APPLICANT’S AMENDED ANSWER TO NOTICE
OF OPPOSITION**

Opposer, GOYA FOODS, INC. (“Opposer”) hereby moves to strike Applicant’s First and Second affirmative defenses as plead in its Amended Answer to the Notice of Opposition.

This motion is timely made within the time prescribed in Fed. R. Civ. P. 12(f).
See also TMBP §506.02.

Granting this motion will be helpful in narrowing and limiting issues in this proceeding, thereby also serving as a guide in conducting discovery. As stated in 2A Moores Federal Practice paragraph 12.21[3]:

Although courts are reluctant to grant motions to strike, where a defense is legally insufficient, the motion should be granted in order to save the parties unnecessary expenditure in time and money in preparing for trial.

This is the Applicant’s second stab at what are essentially two of the same affirmative defenses previously stricken by the Board. The only difference is that Applicant has added some facts, none of which could possibly arise to a level of

reasonable reliance and none of which legally or factually support the defenses alleged. They fail for many of the same reasons previously set forth by the Board in its decision dated June 14, 2013. Accordingly, Opposer files the instant motion to strike.

Applicant's First and Second Affirmative Defenses rely upon the same set of alleged facts and are discussed together below.

APPLICANT'S FIRST AND SECOND AFFIRMATIVE DEFENSES SHOULD BE STRICKEN

Applicant's First Affirmative defense is "acquiescence," stated by Applicant at paragraph 1 as: "Opposer has acquiesced to Applicant's use of the mark in issue."

Applicant's Second Affirmative defense is "estoppel," stated by Applicant at paragraph 2 as: "Opposer is estopped from asserting any claims against Applicant arising out of matters alleged in the Notice of Opposition."

The facts alleged by Applicant in support of its defenses may be summarized as:

1. Applicant owns Reg. No. 1934691 for the mark CASERO for "cheese" (the "'691" registration) and owns Reg. No. 3720632 for the mark CASERA for "cheese and dairy products" and for "flour, corn flout, and instant corn flour mix" (the "'632 registration");
2. Opposer took no action against the '691 or '632 registrations;
3. Opposer at some time had knowledge of the above registrations and allegedly knew of Applicant's use of the above marks on the above goods; and

4. Opposer had previously made mention of the '691 and the '632 registrations within a list of other third party registrations in a motion for summary judgment filed by Opposer in an unrelated third party proceeding (solely for purposes of showing, in general, the English translation of the terms "casera" and/or "casero" by third parties).

Even if all the above facts were proven at trial, they would not support application of the equitable defenses alleged by Applicant.

Applicant then goes on to simply parrot the verbiage required to allege the defenses in issue, namely:

1. The above facts evidence that Opposer engaged in misleading conduct;
2. The alleged misleading conduct (whatever it may have been) lead Applicant to reasonably infer that Opposer's rights would not be asserted against Applicant's current application;
3. Applicant relied on such assurances (it being unstated what "assurances" Applicant is referring to); and
4. Applicant will be materially prejudiced if the delayed assertion of Opposer's rights is permitted.

None of the actual facts alleged by Applicant could in any way reasonably be said to support the defenses alleged.

Regarding Applicant's ownership of the '691 registration and the '632 registration (both of which were previously alleged at paragraph 5 of Applicant's original affirmative defenses and both of which were, in part, the subject of Opposer's original motion to strike), the Board ruled in its June 14th Decision *at* pp. 8-9:

[A] laches defense in an opposition proceeding may be based upon opposer's failure to object to an applicant's

earlier registration of substantially the same mark for substantially the same goods. [citing case]

However, applicant's laches defense, for the same reasons as its alluded to *Morehouse* defense, would not apply in this circumstance. Where, as in the present case, the goods in the subject application are not substantially similar to the goods claimed in the prior registration, neither *Morehouse* nor the narrow circumstances for use of laches applies. [citing case]"

Accordingly, the registrations cited by Applicant, insofar as Applicant is attempting to rely upon the same for purposes of its alleged equitable affirmative defenses, are irrelevant.

Regarding the third party opposition proceeding referred to by Applicant, Applicant alleges a truly novel basis for its alleged defense. Applicant correctly alleges that Opposer filed Opposition No. 91198986 against a third party application, namely against Ser. No. 77924022 for the mark LA CASERA for "tortillas." (App's Amended Pleading, p. 4 subsection vii). Applicant fails to include the fact that Opposer was successful, that judgment was entered against said applicant, the opposition sustained and registration to said applicant was refused. See Exhibit 1 annexed hereto.

What Applicant further fails to mention is that the third party therein had asserted counterclaims in said proceeding, that Opposer filed a motion for summary judgment (i.e., the one referred to by Applicant herein) on said counterclaims, that the applicant in response withdrew its counterclaims, and that the counterclaims were accordingly dismissed with prejudice. See Exhibit 2 annexed hereto. In the above referenced motion for summary judgment Opposer referred to the two registrations owned by Applicant herein (in a list amongst other third party marks) solely to show how the term "casera(o)" is translated by others from Spanish to English. These are the same registrations (i.e., the

‘691 registration and the ‘632 registration) that the Board has already stated: “Where, as in the present case, the goods in the subject application are not substantially similar to the goods claimed in the prior registration, neither *Morehouse* nor the narrow circumstances for use of laches applies. [citing case].”

Somehow, Applicant reasons that Opposer’s reference to the ‘691 and ‘632 registrations in a successful opposition to an unrelated third party application constitutes an act of acquiescence magically running to Applicant, which Applicant somehow allegedly relied upon in filing the current application and which requires application of the doctrine of estoppel. This is so far-fetched as to be devoid of reason.

Further, it is highly improbable that Applicant accessed the TTAB database for said opposition, found and read through Opposer’s motion for summary judgment, and happened to notice mention of the ‘691 registration and the ‘632 registration (which are nevertheless irrelevant to the present issue) in a list of third party registrations on the issue of English translation, and somehow relied upon such mention as an affirmative act of Opposer constituting acquiescence and estoppel as applied to the application in issue in this proceeding.

As the Board stated in its June 14th Decision, it is a rule “that the defenses of laches, acquiescence or estoppel are generally not available in an opposition proceeding.” *See Barbara’s Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1292 n.14 (TTAB 2007).

And, as stated at p. 11 of the prior Decision:

Applicant does not allege that opposer engaged in any conduct, or failed to act when required, which led applicant in filing the subject application to rely on opposer’s conduct as indicating its intention not to assert its rights.

Any reasonable review of Applicant's pleading does not uncover any facts which, if proven, would support its alleged affirmative defenses. There is nothing in the facts alleged by Applicant that could reasonably have put Applicant on notice that Opposer did not intend to assert its rights against the application in issue in this proceeding. Because Applicant's defenses lack any reasonable support they must be stricken.

CONCLUSION

Upon motion, or upon its own initiative, the Board may order stricken from a pleading any insufficient defense. *See* Fed. R. Civ. P. 12(f). WHEREFORE, in view of the materials presented herein, Opposer prays its motion be granted in all respects.

Dated: July 18, 2013

Respectfully submitted for Opposer,

GOYA FOODS, INC.

By: John M. Rannells/
John M. Rannells
Attorney for Opposer
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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing MOTION TO STRIKE was sent to the attorneys for Applicant this 18th day of July, 2013 via first class mail, postage prepaid, to the following address:

Gregory Owen
OWEN, WICKERSHAM & ERICKSON, P.C.
455 Market Street, 19th Floor
San Francisco, California 94105

Dated: July 18, 2013

/John M. Rannells/

John M. Rannells

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Applicant.	:	
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-----X	:	

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EXHIBIT 1

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

nmt

Mailed: May 22, 2012

Opposition No. 91198986

Goya Foods, Inc.

v.

Olé Mexican Foods, Inc.

On May 19, 2012, applicant filed an abandonment of its application Serial No. 77924022 under Trademark Rule 2.68.

However, the applicable rule is Trademark Rule 2.135, which provides that if, in an inter partes proceeding, the applicant files an abandonment without the written consent of every adverse party to the proceeding, judgment shall be entered against the applicant.

Accordingly, because opposer's written consent to the abandonment is not of record, judgment is hereby entered against applicant, the opposition is sustained and registration to applicant is refused.

Additionally, while the opposition remains sustained, applicant is allowed July 21, 2012 to inform the Board how it wishes to proceed with respect to the counterclaim,

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EXHIBIT 2

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451**

vw/jk

Mailed: February 21, 2013

Opposition No. 91198986

Goya Foods, Inc.

v.

Olé Mexican Foods, Inc.

On January 29, 2013, applicant/counterclaim plaintiff filed a withdrawal of its counterclaims.

Inasmuch as opposer/counterclaim defendant's written consent to the withdrawal is not of record, and the withdrawal of the counterclaims was filed after answer thereto, the counterclaims are dismissed with prejudice.

In view thereof, opposer/counterclaim defendant's December 11, 2012 motion for summary judgment, and December 27, 2012 notice of service, are moot and will be given no further consideration.

***By the Trademark Trial
and Appeal Board***